

132407-2
(GE3-0029)

REMARKS

Applicants elect, with traverse, the claims identified by Group (I) drawn to a coating. The Requirement for Restriction contends that the application is drawn to the following distinct inventions:

Group (I): Claims 1-6, drawn to a coating, classified in class 428, subclass 472;

Group (II): Claims 7-10, drawn to a turbine, classified in class 415, subclass 55.5;
and

Group (III): Claims 11-14, drawn to a method, classified in class 427, subclass 446.

The Examiner requires restriction of Groups I and II on the grounds that the inventions are mutually exclusive species in an intermediate product relationship. Groups II and III are related as a process of making and product made. The Applicants believe this restriction to be improper and unduly burdensome. The reasons given in the Office Action for requiring restriction are believed to be insufficient and contrary to the rules.

The rules require the Examiner to show that there would be some undue burden on the PTO to examine separate inventions in a single application. M.P.E.P. §803 sets forth the manner in which the Examiner must proceed as follows:

“If the search and examination of an entire application can be made without serious burden, the Examiner must examine all claims on the merits, even though it includes claims to distinct or independent inventions.” [emphasis added]


The Examiner has given no indication that there would be a serious burden of the type required and defined in the M.P.E.P. Applicants do not believe the scope of the search proposed is unduly burdensome. For example, the search for the provisionally elected invention of Group I will likely require an overlapping search of the class and subclass defined by the invention of Group II.

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The Commissioner is hereby authorized to charge any required fee or fee deficiency under 37 C.F.R. § 1.17 in connection with this communication to our Deposit Account No. 06-1130.

Respectfully submitted,

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